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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,621	09/15/2000	Christine Andreis	2119-4203	9229

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E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
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WILMINGTON, DE 19805

EXAMINER

NGUYEN, KIMBERLY T

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 01/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/600,621

Applicant(s)

ANDREIS ET AL.

Examiner

Kimberly T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2002 .
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

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DETAILED ACTION

Response to Amendment

This action is in response to the amendment submitted on December 23, 2002. It is acknowledged that claims 7 and 20 are cancelled.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claims 1-5, 8-11, 13-15, and 21-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Shetty et al., U.S. Pat. No. 5,837,359 as previously stated in the Office Action submitted on July 19, 2002.

As to the newly added limitation in claim 1 that the particle size of the pigment is between 0.02 and 1.0 microns, Shetty shows in column 1, lines 26-35, that it is known to make such films with a skin material containing pigments of particle sizes less than or equal to 1 micron.

Claim Rejections - 35 USC § 103

Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shetty et al., U.S. Pat. No. 5,837,359 in view of Utsumi et al., U.S. Pat. No. 5,510,192.

Shetty is relied upon as above for claim 1. Shetty does not specifically show the concentrations of the pigment as in instant claims 16-18 or the thickness as in instant claim 19. However, such concentrations or thicknesses are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the concentrations or thicknesses, absent a showing of unexpected results, it is obvious to modify the conditions of a composition

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because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. concentrations or thicknesses) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are result-effective as they control the glossiness, opacity, and mechanical and physical strength of the film. As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the film with the limitations of the pigment concentration or layer thickness since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shetty et al., U.S. Pat. No. 5,837,359 in view of Utsumi et al., U.S. Pat. No. 5,510,192 as previously stated in the Office Action submitted on July 19, 2002.

Response to Arguments

Applicants' argument filed December 23, 2002 have been fully considered but they are not persuasive.

On pages 2-3, Applicants argue that Shetty discloses and requires the pigment particles to be 2-15 microns instead of the range claimed in instant claim 1. Examiner disagrees because Shetty does not absolutely require such a range and that the pigment particles "should be small enough" to achieve desired haze levels. Further, Shetty shows in column 1, lines 26-35 that it is known that pigment particle sizes can be less than or equal to 1 micron.

On pages 2-3, Applicants argue that the problem and solution faced by Shetty differs from the problem and solution set forth in the present invention. This argument is not persuasive

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because Applicants are arguing as to the intended use of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It does not matter what the intended use is in an article claim. The combination of the inventions in Shetty and Utsumi shows Applicants' invention without any structural differences. Thus, such a combination would be capable of solving the same problems which Applicants intend to solve. The prior art structure of Shetty and Utsumi thus meet the claims of Applicant's disclosure.

On page 3, Applicants argue that the concentration of pigment is not merely optimizable and that Shetty does not show the 5 weight % or more limitation as in instant claim 1. Examiner disagrees because, as previously stated in the Office Action submitted on July 19, 2002, Shetty shows that the layers comprise up to 12.5% of the pigment (column 3, lines 37-55).

On page 3, Applicants argue that a preferred pigment is a white pigment. Examiner is not persuaded by this argument because Applicants have not claimed this limitation. Regardless, Shetty shows a white pigment in column 3, lines 35-55.

On page 3, Applicants argue that Utsumi does not cure the deficiencies of Shetty. This argument is not persuasive because it is shown above that Shetty does disclose the particle sizes. Further, Utsumi is used *in combination with* Shetty to show that it is known to use master-batches to make the crystalline polyester film.

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Conclusion

Applicant's AMENDMENT necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

